

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

Boston Scientific Corp. and Target
Therapeutics, Inc.,

NO. C 02-01474 JW

Plaintiffs,

**ORDER GRANTING DEFENDANT'S
MOTION FOR CLAIM CONSTRUCTION
OF ADDITIONAL CLAIM TERMS**

v.

Cordis Corp.,

Defendant.

I. INTRODUCTION

Boston Scientific Corp. and Target Therapeutics, Inc. ("Plaintiffs") filed this action against Cordis Corp. ("Defendant") alleging infringement of a number of patents relating to methods and devices for treating aneurysms. Presently before the Court is Defendant's Motion for Claim Construction of Additional Claim Terms. Plaintiffs oppose this motion on numerous grounds. Based upon the parties' submissions to date and oral arguments at the hearing on June 27, 2006, the Court GRANTS Defendant's Motion.

II. BACKGROUND

Plaintiffs have alleged that Defendant's Trufill DCS Detachable Coil System infringes numerous claims of U.S. Patents 5,895,385 ("the '385 patent"), 6,010,498 ("the '498 patent"), and 6,238,415 ("the '415 patent"). On September 19, 2003, the Court held a hearing in accordance with Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), to construe the disputed terms and

1 phrases of the asserted claims. On October 7, 2003, the Court issued a Markman Order construing
2 certain terms of the '385, '498, and '415 patents. (Docket No. 177.) A complete background of the
3 technology and patents-in-suit is provided in this Markman Order.

4 On October 1, 2004, Defendant filed an Ex Parte Reexamination Request with the U.S.
5 Patent and Trademark Office ("USPTO") with respect to the '498 patent.¹ (Declaration of Matthew
6 T. Powers in Support of Defendant Cordis' Motion for Claim Construction of Additional Claim
7 Terms, "Def.'s Decl.," Docket No. 859, Ex. 2.) Among other things, Defendant argued that claims 3
8 and 9 of the '498 patent, which describe the distal tip structure of the vascular catheter as "adapted
9 to be multiply folded upon itself," were obvious in light of U.S. Patents 5,261,916 ("the '916
10 patent") and 4,994,069 ("the '069 patent"). (Def.'s Decl. Ex. 2 at 12.) Specifically, Defendant
11 argued the '069 patent disclosed a coil that is "capable of being multiply folded upon itself to
12 occlude the body cavity." (Def.'s Decl. Ex. 2 at 12.)

13 In February 2006, the USPTO mailed a Notice of Intent to Issue Ex Parte Reexamination
14 Certificate ("NIRC") with respect to the '498 patent. (Def.'s Decl. Ex. 1.) The USPTO examiner
15 rejected all of Defendant's arguments. (Def.'s Decl. Ex. 1 at 2.) With respect to Defendant's
16 arguments regarding the '916 and '069 patents, the examiner stated in part:

17 [The] '916 respectfully to the request does not disclose a coil capable of being multiply
18 folded upon itself to fill the cavity of an aneurysm. Instead, Engelson '916 and the Ritchart
19 '069, which is incorporated by reference by Engelson '916, coils are coils having a
20 predetermined shape when no forces are applied to said coils and after the proper amount of
force is placed on the coils in order for said coils to fit inside the catheter to be pushed
therethrough, said coils returned to the predetermined shapes that are generally dictated in
the figures of Ritchart '069 once released by the catheter.

21 (Def.'s Decl. Ex. 1. at 3.)

22 In light of this statement, Defendant filed a motion for claim construction of "multiply folded
23 upon itself," a term which appears in both the '385 and '498 patents. (Defendant Cordis' Motion for
24 Claim Construction of Additional Claim Terms, "Def.'s Mot.," Docket No. 858.) Plaintiffs oppose

27 ¹ A request for reexamination of the '385 patent was filed concurrently with this request.

1 Defendant's motion on numerous grounds. (See Plaintiffs' Opposition to Defendant Cordis' Motion
2 for Claim Construction of Additional Claim Terms, "Pls.' Opp'n," Docket No. 875.)

3 III. DISCUSSION

4 The term "multiply folded upon itself" appears in both the '385 and '498 patents.
5 Independent claims 7, 15, 32, and 38 of the '385 patent each refer to either a "relaxed coil capable of
6 being multiply folded upon itself" or a "deformable object capable of being multiply folded upon
7 itself." Dependent claims 3 and 9 of the '498 patent each describe the "detachable elongate tip
8 portion" as a "substantially pliable segment adapted to be multiply folded upon itself." Although the
9 Court construed the term "relaxed coil" in the '385 patent in its October 7, 2003 Markman Order,
10 the "multiply folded" term has not been construed by the Court.

11 Defendant argues the statements made by the USPTO examiner in the NIRC constitute new
12 intrinsic evidence that warrants construction of the "multiply folded" term. (Def.'s Mot. at 3-4.)
13 Defendant contends the examiner construed "multiply folded upon itself" to exclude prebiased coils
14 or coils of a predetermined shape. (Def.'s Mot. at 1.) According to Defendant, this new evidence is
15 significant because Defendant's products employ prebiased coils. (Def.'s Mot. at 1.) Defendant
16 maintains its products would not fall within the asserted claims containing such a limitation if the
17 examiner's construction is adopted. (Def.'s Mot. at 1.)

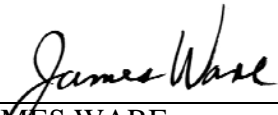
18 Plaintiffs oppose construction of the "multiply folded" term for numerous reasons. First,
19 Plaintiffs argue the claims and specifications of the '385 and '498 patents make it clear the claimed
20 coils include coils that have a prebiased shape. Second, Plaintiffs contend Defendant has taken the
21 examiner's statements out of context and that the examiner really did not construe the claims of the
22 '498 patent to exclude prebiased coils. Finally, Plaintiffs contend the Court previously rejected
23 Defendant's argument that the claims exclude prebiased coils when it construed the term "relaxed
24 coil" in its October 7, 2003 Markman Order. The Court, as Plaintiffs note, said "a prebiased coil is
25 considered a relaxed coil as long after the coil is deployed in the vascular cavity the coil results in a
26 shape that loosely deforms to the interior shape." (Docket No. 177 at 18.)

1 Despite the arguments Plaintiffs advance as to why the Court should not order claim
2 construction of the “multiply folded” term, the Court is not convinced it should refrain from
3 construing this additional term. Plaintiffs may be correct in that the claims and specification of the
4 ‘385 and ‘498 patents indicate the claimed coils may have a prebiased shape, but the Court finds this
5 is an issue that should be resolved through further construction of the claim terms. Additionally, the
6 Court does not find its previous construction of “relaxed coil” in the ‘385 patent obviates the need
7 to construe the “multiply folded” term, which appears in both the ‘385 and ‘498 patents.

8 **IV. CONCLUSION**

9 The Court GRANTS Defendant’s Motion for Claim Construction of Additional Claim
10 Terms. The parties shall submit supplemental briefs regarding construction of the “multiply folded”
11 term on or before July 11, 2006. Such briefs shall be no longer than twelve (12) pages in length, not
12 including exhibits. Any reply briefs shall be no longer than five (5) pages in length and filed on or
13 before July 18, 2006.

14
15 Dated: June 27, 2006



JAMES WARE
United States District Judge

THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:

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Dated: June 27, 2006

Richard W. Wieking, Clerk

By: /s/ JW Chambers

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